



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/413,963	10/07/99	LYNCH	J 85160.911CII

HECKER & HARRIMAN
1925 CENTURY PARK EAST
SUITE 2300
LOS ANGELES CA 90067

LMC1/0530

EXAMINER

KNOX, L

ART UNIT

PAPER NUMBER

2763

DATE MAILED:

05/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/413,963

Applicant(s)

LYNCH ET AL.

Examiner

Lonnie A. Knox

Art Unit

2763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement submitted concurrently with the mailing date of the application on 10/07/99. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the petition is granted and the information disclosure statement is being considered by the examiner.

Oath/Declaration

2. The oath or declaration is defective. Applicant is required to furnish either a new oath or declaration in proper form, identifying the application by application number and filing date, or a certificate by the officer before whom the original oath was taken stating that the oath was executed within the jurisdiction of the officer before whom the oath was taken when the oath was administered. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

3. The declaration included in the application is a copy of a prior application that was allowed after being amended (not indicated on the form).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2763

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richek et al. (US 5,257,387). The examiner observes that the claims in the instant application are identical to those of an application by the present inventors in application number 08/039,949 filed 3/29/93 that culminated, after prosecution and amendments, in an allowance published on 5/7/1996 as US 5,515,524. The examiner takes official notice that the rejections of these original claims by the examiner of that case are still valid and are maintained in this action. That rejection based on 35 U.S.C. § 103 (a) is paraphrased below:

6. Richek et al. taught the invention substantially as claimed, including a data processing ("DP") system (as example in claim 6) comprised:

- a method of configuring a system in a computer (abstract);

- providing structural model hierarchy having structural relationships (see column 4 lines 27-63), column 7 lines 29-64, column 21 lines 28-50, column 22 line 58-column 25 line 34, and claims 9-11) and modifying the instance in response to a request by creating a model based on the request;

- storing the modification as a list (see column 47 lines 7-10);

- examining said instance to determine if a constraint (conflict) exists (see column 42 lines 42-44) and resolving/satisfying the conflict (constraint) when exists (see column 42 lines 45-50).

7. Richek et al. did not specifically detail instance or constraint exactly as claimed in the instant application. However, it would have been obvious to a person of ordinary skill in the art, at the time the claimed invention was made; Richek's configuration file statement including fields is the same as the claimed instance, and the claimed constraint is the same as Richek's conflicts.

8. As to claims 1,5,12, 13, 14 and 15, since these claims are an obvious modification of claim 6, claims 1,5,12, 13, 14 and 15 are rejected based on the rejections of claim 6.

9. In commenting on applicants' arguments to the above rejections, that examiner in a Final Rejection indicated that the arguments were not persuasive and the original rejection was maintained as regards to amended claims 1, 4 and 6 and original claims 2-3, 5, 7-8, 10 and 12. Applicant argued that;

- a. The configuration file of Richek was not a structural model that defined base classes, derived classes, composite, container hierarchy or port relationship structures as in the claimed invention.
- b. Richek did not teach a method for instantiating a component to satisfy a resource allocation conflict nor did he describe a generative approach to configuring systems.
- c. Richek did not provide the ability to add a component nor use constraints.
- d. In Richek a conflict did not provide information that could be used to determine whether a component might be added to the configuration.

10. As to item 7a above that examiner noted that: Richek did not specifically teach a hierarchical structure model exactly as the claimed system. However, it would have been obvious to a person of ordinary skill in the art to use hierarchy in the configuration file due to the need of the complex system design.

11. As to item 7b-7d above that examiner noted that; since the applicant did not specifically point out and distinctly claim these features in the rejected claims, the argument was not persuasive.

12. That examiner objected to claims 9 and 11, but was persuaded that claims 9 and 11 contained patentable material and would be allowed if rewritten in independent form including all of the limitation of the base claim and any intervening claims.

13. That examiner also was persuaded that claims 13-15 were allowable over the cited prior art.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dolby et al (US 5,630,025). Dolby teaches an expert system for generating a configuration for any complex system consisting of multiple components as described in the instant invention. Dolby's teachings include defining complex systems (including a

computer system), generating the system configuration, and displaying via a GUI the graphical representation based on user requests and constraints. Dolby further teaches instantiating and interconnecting the elements including cabinets, backplanes, input/output channels, power supplies and peripheral devices. Dolby also teaches creation of a price list.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. US 5,307,261 (Maki et al.) 4/26/94, 'Method and System for Product Configuration Management in a Computer Based Manufacturing System'. Maki teaches item configuration management including item update and bills of material.
- b. US 5,877,966 (Morris et al.) 3/2/99, 'System and Method for Creating Configurations Using Templates'. Morris teaches use of templates to define and create configurations via a graphical interface.


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lonnie A. Knox whose telephone number is (703) 308-8475. The examiner can normally be reached on 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on (703) 305-9704. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-1396 for regular communications and (703) 308-1396 for After Final communications.

Art Unit: 2763

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Lonnie Knox
May 18, 2000



KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER